

REMARKS

By this amendment: (1) claim 30 is cancelled without prejudice; and (2) claim 31 is amended to cure the indefiniteness referred to by the Examiner.

This application now contains claims 1-15, 17-29 and 31. In view of the above amendments and the remarks hereinafter, it is respectfully requested that this application be reconsidered.

Claim 31 has been amended to remove the objection under 35 U.S.C. 112.

The rejection of claims 11-12 under 35 U.S.C. 102(b) as being anticipated by Boon is respectfully traversed. Claim 11 recites "a casing at least partly encasing the control housing and the pressure pad". Boon does not disclose such a casing. The pressure pad and casing as shown in FIG. 1 is electrically connected through the external cable 40 to the control unit. This is more clearly shown in FIG. 3 in which the control unit is shown by the integrated circuit at 58 and the casing is shown at 10 with the two being interconnected by the cable 40. Claim 12 depends from claim 11 and avoids a rejection under 35 U.S.C. 102(b) for the same reason.

The rejection of claims 7 - 10 under 35 U.S.C. 102(b) as being anticipated by Cross is respectfully traversed. Claim 7 recites "placing a pressure pad under the patient that activates a first switch when energized". Cross does not disclose this. Claims 8, 9 and 10 depend from claim 7 and avoid a rejection under 35 U.S.C. 102(b) for the same reason.

The rejection of claims 1, 3, 6, 14, 15 and 26-27 under 35 U.S.C. 103 as being unpatentable over Boon is respectfully traversed. It is believed that the Examiner meant the rejection to be under 35 U.S.C. 102 or 35 U.S.C. 103 although there appears to be a

typographical error causing it to be written in a slightly different format, "35 U.S.C. 102(3)", but since there is no section of the statute that is 35 U.S.C. 102(3), it is assumed that it was intended to be 35 U.S.C. 102 or 35 U.S.C. 103. It is clear from the Examiner's language after that recitation that the Examiner concedes there is no rejection under 35 U.S.C. 102 since the Examiner has specifically stated that Boon does not disclose some of the claimed recitations.

As to 35 U.S.C. 103, the Examiner has provided no support for the allegations that it would be obvious to a person of ordinary skill in the art to dispose of the pad after use or to tear the plastic after use so it could not be used again or to cause the alarm to be provided only upon the release of pressure after the pressure has been applied continuously for a period of time. It is the Examiner's burden to provide some rationale by showing that such steps have been taken in analogous prior art or that there is some reason to believe a person of ordinary skill in the art would have sufficient knowledge to perform those steps based only on the patent to Boon which does not teach them. Indeed, since those steps require additional cost, it should be assumed that a person of ordinary skill in the art would not utilize them without a reason but the only reasons for utilizing them are provided in the specification of this patent application. The Examiner has described no prior art providing such a reason.

It is not obvious to provide single use of the pad because it costs money and it is not obvious that it would be necessary to take a step such as tearing the plastic when the patient is released or that there is any need for circuitry that will prevent the alarm from being given upon the initial pressure being applied to the pad. Why would a person of

ordinary skill in the art know that the alarm should not be given unless the patient has been on the pressure pad for a predetermined period of time rather than providing an alarm every time that the patient leaves the pad. It had to be discovered that this was a problem and inventions that are not obvious and that come about as a result of discovery are patentable under the statute.

The rejection of claims 17-20 under 35 U.S.C. 102 or 35 U.S.C. 103 as being unpatentable over Boon in view of Smith is respectfully traversed. 35 U.S.C. 102 cannot be applied to a rejection of claims as being unobvious over one reference in view of another. It must only be anticipated by a single reference. Assuming the Examiner intended to reject claims 17- 20 under 35 U.S.C. 103 as being unpatentable over Boon in view of Smith, this rejection is also traversed. It is not obvious to a person of ordinary skill in the art to reject two parts of a combination merely on the ground that those two parts exist in the prior art. There must be some suggestion or teaching that would cause a person of ordinary skill in the art to combine the teachings of Boon and the teachings of Smith or a *prima facie* case of obviousness has not been made out. In this case, there is no suggestion or teaching that would cause one to include the gel pad of Smith into the pad of Boon. Each of these two disclosures is entirely independent and serve a complete function by themselves while the function of the combination claims 17-20 is not taught at all.

Moreover, it is not proper to reject the claims with the mere statement that it would be obvious to avoid faults by not activating the alarm until a predetermined time has passed in the absence of a teaching that is not found in the patent application itself. A

claim cannot be rejected on the ground that the inventor in the same application has disclosed the feature or the advantage of the feature. There must be an outside prior art teaching that false alarms will be reduced or some logic indicating such a reduction in false alarms would occur. In this case, there is no such prior art teaching and the delay period would be unobvious to a person of ordinary skill in the art.

The rejection of claims 2, 4 - 5, 7 - 10, 13, 21 - 23 and 28 - 30 under 35 USC 103(a) as being unpatentable over Boon in view of Triplett et al, is respectfully traversed.

Claims 4 and 5 depend from claim 1 and incorporate each of the recitations of claim 1.

1. Neither Triplett nor Boon disclose the steps of

“preventing at least one of said step of arming the pressure pad and said step of activating an alarm when at least one of said step of applying pressure above said predetermined pressure and said step of removing said pressure above said predetermined pressure are separated in time by more than a preset period of time; and

disposing of the pressure pad when the patient no longer has use of the pressure pad without permitting use by another patient.”.

The Examiner has failed to establish a *prima facie* case showing that such limitations would be obvious to a person of ordinary skill in the art. It is not adequate to merely repeat an advantage that is given in the application specification itself to indicate that it would be obvious. There must be some external evidence indicating obviousness and there is no such external evidence presented by the Examiner. Accordingly, the Examiner has not established a *prima facie* case.

Claims 2, 21 and 22 depend directly or indirectly from claim 1 and are patentable over the combination of Boon in view of Triplett for the same reason as claim 1. Moreover,

neither Boon nor Triplett disclose a voice message nor a photoelectric sensor nor has the Examiner relied on any teaching that would make them obvious.

Claim 23 includes the recitations:

"activating an alarm when the pressure above said predetermined pressure has been on the pressure pad for a predetermined time and is removed from the armed pressure pad after said predetermined time; and

disposing of the pressure pad when the patient no longer has use of the pressure pad without permitted use by another patient;

wherein... and a voice message is announced near the patient wherein the step of placing said second sensor in juxtaposition with the first sensor includes the substep of detecting the direction of motion of the patent.”.

Neither Triplett nor Boon disclose these features nor is there any indication in the Examiner's argument that they are disclosed in the prior art. Moreover, no reason is given why they would be obvious to a person of ordinary skill in the art. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

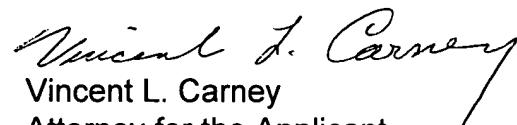
Similarly, claim 28 recites “a casing at least partly encasing the control housing and the pressure pad”. Neither Triplett nor Boon disclose this feature. Accordingly, the Examiner has failed to establish a *prima facie* case of unpatentability of those claims. A *prima facie* case is not established by merely asserting that the missing elements in the prior art are obvious. There must be some logical reason based on fact causing them to be unobvious and no such reason has been given by the examiner.

Claim 30 has been cancelled.

The rejection of claim 13 as being unpatentable over Boon in view of Cross under 35 U.S.C. 103 is respectfully traversed. Claim 13 depends from claim 1 and is patentable for the same reason. Moreover, the mere assertion that it would be obvious to include a voice warning message is not sufficient to create a *prima facie* case in the absence of evidence. It is not true that everything not disclosed in the prior art must be known or obvious. The presumption is that elements not shown in the prior art are unobvious not that they are obvious. Otherwise, no new invention would be patentable since anything not disclosed in the prior art but in a claim drafted to the invention could be asserted to be obvious.

Since each of the claims now in this application defines patentably over each of the cited references and every combination of the cited references and since the claims are proper and definite, it is respectfully requested that they be allowed and this application be passed to issue.

Respectfully submitted,


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